

DOCKET NO.: JANS-0026 (JAB-1499 US)
Application No.: 10/019,380
Office Action Dated: July 14, 2003

PATENT

REMARKS/ARGUMENTS

Claims 1 to 22 are pending in this application and claims 12 to 14, 16 and 17 are withdrawn from consideration. Claim 9 is rejected under 35 U.S.C. § 112, first paragraph. Claims 1 to 11, 15 and 18 to 22 are rejected under 35 U.S.C. § 112, second paragraph. Applicants are herein amending claims 1, 8 to 9, 15, and 20 to 22 and cancelling claims 2, 12 to 14, 16 and 17, without prejudice or disclaimer. Applicants are herein amending the specification to resubmit the Abstract of the Disclosure, as filed in the PCT application.

Amendments

Applicants are herein amending claims 1, 8 to 9, 15, and 20 to 22 and cancelling claims 2, 12 to 14, 16 and 17, without prejudice or disclaimer. Applicants are herein amending claim 1 to present the Z moiety in a more proper format. Applicants are amending claim 8 to delete the phrase “(compound 75).” Applicants are herein amending claim 9 to present it as a method of treating a respiratory syncytial viral infection, as described, *inter alia*, in the specification on page 40, lines 5 to 32. Applicants are herein amending claim 15 to delete each use of the term “suitable” and correct other minor grammatical errors.

Applicants are herein amending claims 1, 8, 15 and 20 to 22 and cancelling claim 2, 12 to 14, 16 and 17, without prejudice or disclaimer, to delete the non-elected subject matter. Applicants wish to reserve the right to file one or more divisional applications to pursue the non-elected subject matter.

Applicants are herein amending the specification to add an ABSTRACT OF THE DISCLOSURE. An abstract was filed with the PCT Application of which the current application is a National Stage Application. Minor changes have been to the abstract relative to the abstract filed with the PCT Application, specifically to reduce the total numbers of

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words and to reflect that the compounds of the invention are useful in methods for treating respiratory syncytial viral infections.

Applicants respectfully submit that the amendments to the specification and claims are ministerial in nature; do not introduce new matter; and are fully supported by the specification, as originally filed.

Restriction Requirement

Applicants are herein amending claims 1, 8, 15 and 20 to 22 and cancelling claim 2, 12 to 14, 16 and 17, without prejudice or disclaimer, and reserve the right to file one or more divisional applications directed to the cancelled subject matter.

Rejection under 35 U.S.C. § 112, first paragraph

Claim 9 is rejected under 35 U.S.C. § 112, first paragraph, as allegedly non-enabled for all viral infections. Applicants are herein amending claim 9 to further specify that the compounds of the invention are useful in methods of treating *respiratory syncytial* viral infections. Applicants submit that these amendments render moot the rejection of claim 9. Accordingly, applicants respectfully request the withdrawal of the rejection under 35 U.S.C. § 112, first paragraph.

Rejection under 35 U.S.C. § 112, second paragraph

Claims 1 to 11, 15, and 18 to 22 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite, specifically with respect to the Z moiety in claim 1 and the use of compound 75 and the terminology “[*(A), (S)*]” and “[*(B, S)*]” in claim 8. Applicants respectfully submit that claims 1 to 11, 15, and 18 to 22, as amended, are definite.

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Applicants respectfully submit that the terminology “[**(A), (S)**]” and “[**(B, (S)**]” is clearly defined in the specification on page 6, lines 9 to 20:

For some of the compounds of formula (I), their prodrugs, N-oxides, salts, solvates, quaternary amines, or metal complexes and the intermediates used in the preparation thereof, the absolute stereochemical configuration was not experimentally determined. In these cases the stereoisomeric form which was first isolated is designated as “A” and the second as “B,” without further reference to the actual stereochemical configuration. However, said “A” and “B” stereoisomeric forms can be unambiguously characterized by for instance their optical rotation in case “A” and “B” have an enantiomeric relationship. A person skilled in the art is able to determine the absolute configuration of such compounds using art-known methods such as, for example, X-ray diffraction. In case “A” and “B” are stereoisomeric mixtures, they can be further separated whereby the respective first fractions isolated are designated “A1” and “B1” and the second as “A2” and “B2,” without further reference to the actual stereochemical configuration.

Applicants are herein amending claims 1 and 8 and submit that these amendments render moot the remaining basis for the rejection of the claims for indefiniteness. Accordingly, applicants request withdrawal of the rejection of claims 1 to 11, 15, and 18 to 22, under 35 U.S.C. § 112, second paragraph.

Conclusions

Applicants respectfully request:

- (1) entry of the amendments to the specification and claims;
- (2) reconsideration and withdrawal of the rejection of the claims; and
- (5) allowance of claims 1, 3 to 11, 15, and 18 to 22, as amended.

If the Examiner is of a contrary view, the Examiner is requested to contact the undersigned attorney at (215) 557-3861.

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Date: October 8, 2003

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